

### **REMARKS**

This paper responds to the Final Office Action dated April 1, 2010. Claims 1-4, 8-14, and 18-21 are presently amended. No claims are presently canceled. Claims 5-7 and 15-17 were previously withdrawn. No claims are added. As a result, claims 1-4, 8-14, and 18-21 are now pending further examination in this application.

#### **Claim Amendments**

Claims 1 and 11 are presently amended for purposes of clarity and to recite subject matter found in Applicants' specification (WO 2005/006758). In particular, page 1, lines 16-18 of Applicants' specification discusses "**time points in a television program, movie, music piece, etc. where such additional information is relevant,**"<sup>1</sup> and page 5, line 10 discusses "**(action(s) to be presented/triggered at a given time point.**"<sup>2</sup> Claim 11 further contains subject matter discussing "module[s] . . . under the control of one or more microprocessors" found in at least page 9, lines 5-31 of Applicants' specification. As discussed below, claim 21 is amended herein to address a rejection under 35 U.S.C. § 101. Claims 2-4, 8-10, 12-14, and 18-20 are amended herein solely for purposes of clarity. Accordingly, Applicants respectfully request that the claim amendments be entered.

#### **Double Patenting Rejection**

Claims 1, 11, 10, 20, 3, 13, 4, 14, 8, 18, and 21 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 15, 2, 16, 3, 17, 4, 18, 14, 28, and 29 respectively of copending Application No. 10/566,003. Applicants note the provisional nature of these rejections and will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b)(iv) should the co-pending application issue prior to issuance of the instant claims herein, to obviate these rejections. Applicants do not admit that any of the claims 1, 11, 10, 20, 3, 13, 4, 14, 8, 18, and 21 are obvious in view of copending Application No. 10/566,003.

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<sup>1</sup> Emphasis added.

<sup>2</sup> Emphasis added.

*The Rejection of Claims Under § 101*

Claim 21 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. According to instructions issued by the Office, “[a] claim drawn to such a computer readable medium . . . may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘**non-transitory**’ to the claim.”<sup>3</sup> The Office has instructed that, “[s]uch an amendment would typically not raise the issue of new matter.”<sup>4</sup> Claim 21 is amended herein to include the limitation “non-transitory.” Applicants respectfully submit that, as amended herein, claim 21 does not encompass nonstatutory subject matter. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claim be allowed.

*The Rejection of Claims Under § 112*

Claim 21 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As noted above, claim 21 is amended herein to include the limitation “**non-transitory**.” Applicants respect to submit that, as amended herein, claim 21 is not indefinite. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claim be allowed.

*The Rejection of Claims Under § 102*

Claims 1-4, 8-14, and 18-21 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Rhoads et al (U.S. Patent Application Publication 2002/0032864, “Rhoads”). To

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<sup>3</sup> USPTO Notice, “Subject Matter Eligibility of Computer Readable Media,” issued January 26, 2010, emphasis added.

<sup>4</sup> *Id.*

anticipate a claim, a reference must disclose **each and every element** of the claim,<sup>5</sup> as arranged in the claim,<sup>6</sup> and in as complete detail as in the claim.<sup>7</sup>

Independent claims 1 and 11 are each amended herein to recite, in part, “**a trigger time point . . . of a plurality of trigger time points within a multimedia signal, the trigger time point . . . corresponding to a segment of a plurality of segments of the multimedia signal.**”<sup>8</sup> Although Rhoads mentions “shorter windows [than the entire audio track]”<sup>9</sup> and “fingerprints from short excerpts” of a song,<sup>10</sup> nothing in Rhoads describes a trigger time point as corresponding to any window or excerpt. Rhoads makes no mention of a trigger time point within a multimedia signal, much less a trigger time point of a plurality of trigger time points within the multimedia signal. As a result, Rhoads does not and cannot disclose a trigger time point corresponding to a segment of the multimedia signal. Thus, Rhoads fails to disclose at least these claim elements.

Moreover, independent claims 1 and 11 are each amended herein to recite, in part, “**an action that corresponds to the trigger time point.**”<sup>11</sup> While Rhoads states that “[o]nce a song has been identified in a database, a number of different responses can be triggered,”<sup>12</sup> none of the responses of Rhoads are described as corresponding to a trigger time point. Mere identification of a song does not constitute a trigger time point within the song, at least because identification of the song may occur independently of any time point within the song. Nowhere does Rhoads describe the triggered responses of Rhoads as corresponding to any time point within a

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<sup>5</sup> “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential), emphasis added.

<sup>6</sup> “To establish anticipation, every element and limitation of the claimed invention must be found in a single prior art reference, **arranged as in the claim.**” *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383; 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential), emphasis added.

<sup>7</sup> “The identical invention must be shown **in as complete detail** as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), cited in MPEP § 2131, emphasis added.

<sup>8</sup> Emphasis added.

<sup>9</sup> Rhoads at paragraph 0022.

<sup>10</sup> *Id.* at paragraph 0023.

<sup>11</sup> Emphasis added.

<sup>12</sup> Rhoads at paragraph 0027, emphasis added.

multimedia signal. Accordingly, Rhodes is silent with respect to an action that corresponds to a trigger time point within a multimedia signal.

While Rhoads discusses “fingerprinting algorithms . . . that work on much shorter windows [than an entire audio track],”<sup>13</sup> nothing in Rhoads makes any mention of a triggered response corresponding to one of these “shorter windows.” Instead, the responses of Rhoads are triggered merely upon identification of a song. As examples of triggered responses, Rhoads describes “impos[ing] a set of **usage controls** corresponding to terms set by the copyright holder [of a song] . . . , identify[ing] metadata **related to the song** . . . , [returning **title and artist** information] to the user . . . , [and giving] the user . . . an option to purchase **the music** in CD or electronic form . . . .”<sup>14</sup> None of these examples correspond to a trigger time point within a song.

In fact, according to Rhoads, a single excerpt may be insufficient to identify a song and hence may be insufficient to trigger a response. Rhoads explicitly states that “[i]n . . . systems employing fingerprints from short excerpts, a first fingerprint may be found to match 10 songs”<sup>15</sup> and that “[t]o resolve this ambiguity, subsequent excerpt-fingerprints can be checked.”<sup>16</sup> Rhoads discusses “fingerprints from short excerpts” but fails to describe any triggered response as corresponding to one of these “short excerpts.” Thus, Rhoads does not disclose “**an action that corresponds to the trigger time point,**” as recited in the independent claims.

Furthermore, independent claims 1 and 11 are each amended herein to recite, in part, “the trigger time point ( $T_n$ ;  $T_{n+1}$ ) indicates a **time point** within the multimedia signal **at which the action is to be triggered during a playback** of the multimedia signal.”<sup>17</sup> As noted above, the responses of Rhoads are triggered “[o]nce a song has been identified.”<sup>18</sup> Triggering a response once a song has been identified has nothing to do with a time point within a multimedia signal. Mere discussion of triggering a response once a song has been identified fails to disclose a time

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<sup>13</sup> *Id.* at paragraph 0021.

<sup>14</sup> *Id.* at paragraph 0027, emphasis added.

<sup>15</sup> *Id.* at paragraph 0023.

<sup>16</sup> *Id.*

<sup>17</sup> Emphasis added.

<sup>18</sup> Rhoads at paragraph 0027.

point, within a multimedia signal, at which an action is to be triggered during playback of the multimedia signal. Thus, Rhoads does not disclose this claim element.

Independent claim 21 recites claim elements similar to those recited in independent claim 1. Because **each and every element** of independent claims 1, 11, and 21 is not disclosed in the cited reference, as arranged in the claims, and in as complete detail as in the claims, no *prima facie* case of anticipation is established with respect to the independent claims. For at least these reasons, independent claims 1, 11, and 21, and their respective dependent claims, are patentable over the cited reference. Moreover, the dependent claims may each be patentable based on elements recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

**CONCLUSION**


Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29 day of June, 2010.

Zhakalazky M. Carrion

Name

Signature

